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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD


|                        |   |
|------------------------|---|
| Proceeding             | 91221951  |
| Party                  | Plaintiff<br>Geoffrey, LLC  |
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| Submission             | Motion to Dismiss - Rule 12(b)  |
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| Date                   | 10/02/2015  |
| Attachments            | Motion to Dismiss Counterclaim - Geoffrey LLC v Hair Are Us Inc - Opposition No 91221951 - 10-2-15.pdf(305630 bytes )                       |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application of            Hair Are Us, Inc.

Application No.            :        86/222,809

Application Date        :        March 17, 2014

Mark                        :        

Opposition No.           :        91221951

|                                   |   |
|-----------------------------------|---|
| _____                             | ) |
| GEOFFREY, LLC,                    | ) |
|                                   | ) |
| Opposer/Counterclaim Defendant,   | ) |
|                                   | ) |
| v.                                | ) |
|                                   | ) |
| HAIR ARE US, INC.,                | ) |
|                                   | ) |
| Applicant/Counterclaim Plaintiff. | ) |
| _____                             | ) |

Hon. Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

Attn.: Trademark Trial and Appeal Board

**MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM**

Pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure and Section 503 of the Trademark Trial and Appeal Board Manual of Procedure, Geoffrey, LLC, Opposer/Counterclaim Defendant in the above-captioned action, by and through its attorneys, Blank Rome LLP, hereby submits a motion to dismiss for failure to state and plead a claim upon which relief can be

granted because the counterclaim filed by Hair Are Us, Inc. does not allege facts that would, if proved, establish any basis upon which U.S. Registration No. 3,859,458 may be cancelled.

Accordingly, for the reasons set forth below, Geoffrey, LLC prays that the Board grant the subject motion and dismiss Hair Are Us, Inc.'s counterclaim for cancellation of U.S.

Registration No. 3,859,458.

#### **BACKGROUND**





Geoffrey, LLC, a Delaware limited liability company, is the owner of U.S. Trademark Registration No. 3,859,458 for the mark



in International Class 35,<sup>1</sup> registered on October 12,

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<sup>1</sup> The services listed in Reg. No. 3,859,458 are: "retail store and on-line retail store services all featuring toys, games, playthings, natural wooden toys, natural plush animals, organic cotton dolls, dolls, doll houses, doll accessories, doll house furniture, furniture, clothing, baby clothing, children's clothing, maternity clothing, outdoor toys, play sets, sandboxes, play swimming pools, swimming aids, pool rings, life jackets and arm floats for recreational use, outdoor play sets, sporting goods and equipment, roller skates, in-line skates, toy cars, toys trucks, toy airplanes, toy vehicle play sets, toy race tracks, toy action figures and play sets, toy activity tables for children with storage, toy boxes, board games, hand-held electronic games, puzzles, dolls, doll accessories, plush toys, educational toys, microscopes, telescopes, binoculars, science experiment kits, nature kits, magic sets, remote control vehicles and toys; retail store and on-line retail store services all featuring dress-up sets, Halloween costumes, books, cassettes, videos, CDs, DVDs, portable digital media players, musical instruments, toy musical instruments and microphones, computers, toy computers, educational computers, computer and video games, computer and video game consoles and accessories, home and car electronics, baby safety items, baby monitors, humidifiers, vaporizers, baby food and formula, food, beverages, and utensils; retail store and on-line retail store services all featuring diapers, medicine, skin and hair care products, bedding and room decor, baby furniture, children's furniture, adult furniture, rocking chairs, lamps, light fixtures, safety gates, safety night lights, rear view mirror attachments, car seats, high chairs, step stools, booster seats, carriages and strollers. retail store and on-line retail store services all featuring bicycles, tricycles, toy motorized vehicles, ride-on toys, playpens, portable playpens, baby travel systems, play yards and beds for children, bed linen, comforters, pillow cases, rugs, wall paper, swings and bouncers, diaper bags

2010. On August 28, 2015, Hair Are Us, Inc. filed a counterclaim seeking to cancel Reg. No. 3,859,458 for  on the basis that the "RUS" component of the  mark is allegedly generic. Hair Are Us, Inc. does not allege that the  mark is generic in its entirety; its cancellation counterclaim is limited solely to the alleged genericness of the  mark's "RUS" component.

#### **STANDARD OF REVIEW**

In order to survive a motion to dismiss for failure to state a claim upon which relief can be granted, a plaintiff (here, Hair Are Us, Inc. as the counterclaim plaintiff) must allege in its counterclaim sufficient factual content that, if proved, would allow the Board to conclude that: (1) the plaintiff has standing;<sup>2</sup> and (2) a valid ground exists for cancelling the registration. Doyle v. Al Johnson's Swedish Restaurant & Butik Ink., 101 U.S.P.Q.2d 1780 (T.T.A.B. 2012); see also T.B.M.P. § 503.02 (June 2015). Specifically, a counterclaim "must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its

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and carriers, bath products and bibs; retail store and on-line retail store services all featuring, pens, paper, crayons, stationery, school supplies, artist supplies, stickers, coloring books, puzzle books, knapsacks, school bags, sports bags, gift cards and gift wrap; gift registry services."

<sup>2</sup> Hair Are Us, Inc.'s standing is not disputed in this Motion.

face.'" Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009) (quoting Bell Atlantic Corp. v. Twombly, 550 U.S. 544, 570 (2007)).

When tested against these established standards for deciding a Motion to Dismiss pursuant to Rule 12(b)(6), Hair Are Us, Inc.'s counterclaim fails as a matter of law.

### **ARGUMENT**

In its counterclaim, Hair Are Us, Inc. has failed to allege any factual content that, if proved, would allow the Board to conclude that a valid ground exists for cancelling Reg. No. 3,859,458. Indeed, as explained infra, Hair Are Us, Inc.'s allegations upon which its counterclaim is based - that the "RUS" portion of the  mark that is the subject of Reg. No. 3,859,458 is generic - is wholly without merit.

First, the genericness allegation is incorrectly and inappropriately pled. Moreover, the claim has no substance and cannot withstand even a modicum of scrutiny. Simply put, the claim is not only entirely baseless and frivolous, but Hair Are Us, Inc. would not be entitled to relief under any set of facts that could be proved to support its claim, even if the counterclaim is construed in the light most favorable to Hair Are Us, Inc., as "RUS" is not generic. Finally, the counterclaim, even if successful, would be futile because Geoffrey, LLC owns more than thirty additional registrations incorporating the "RUS" element, all of which were cited as

bases for the subject opposition against Hair Are Us, Inc.'s application.

**I. Hair Are Us, Inc.'s Counterclaim Does Not Assert a Valid Ground Upon Which Defendant's Registration May Be Canceled.**

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A properly stated pleading is a threshold inquiry directed solely to establish a plaintiff's interest in the proceeding and to establish a basis for relief. A pleading is sufficiently pled when it comports with a court's requirements and provides the defendant with sufficient information on which to provide a proper answer. In this case, however, Hair Are Us, Inc.'s basis for cancellation of Geoffrey, LLC's registration is not properly pled. Hair Are Us, Inc.'s counterclaim requests cancellation of an entire stylized, inherently distinctive, unitary mark based on the alleged genericness of a single component of the mark. Consequently, on its face, the counterclaim is inappropriate and wholly meritless.

**II. Hair Are Us, Inc.'s Counterclaim is Groundless - "RUS" Is Not Generic.**

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Hair Are Us, Inc.'s allegation that "RUS" is generic for Geoffrey, LLC's services is based on a clear misunderstanding of the concept of "generic" terms. "Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services." T.M.E.P. § 1209.01(c) (July 2015). In other words, generic terms are the


words used to identify the type or category of good or service. For instance, the generic term for desk is "DESK," and the generic term for insurance is "INSURANCE." No single person may register a generic term as its exclusive trademark.

In its counterclaim, Hair Are Us, Inc. alleges that the "RUS" component of the  mark is "a generic reference to the limited services offered under the mark, i.e., toys, games, playthings, natural wooden toys, natural plush animals, organic cotton dolls, dolls, doll houses, etc." Amended Answer and Counterclaim ¶ 37. Hair Are Us, Inc. further states that, "[w]ithin the commercial context, the phrase 'R Us' is simply saying 'you can buy a certain product here in our store, as this is what we specialize in selling.'" Id. ¶ 36.

Properly reviewed under the foregoing definition of "generic" terms, neither "RUS" nor "TOYSRUS" (the literal element of the mark that is the subject of Reg. No. 3,859,458) can possibly be construed as generic for the services in connection with which Reg. No. 3,859,458 is registered. Rather, to be deemed generic, the relevant term would instead explicitly identify Geoffrey, LLC's retail store services, e.g., "TOY STORE" or "GAME SHOP." In this case, "RUS" is clearly not a generic reference to Geoffrey, LLC's retail store services. The literal element of this "RUS" component, "are us," is an incongruous term that does not "say" anything about retail store

services, let alone explicitly identify the nature of such services.

Moreover, Hair Are Us, Inc.'s statement that "the phrase 'R Us' is simply saying 'you can buy a certain product here in our store, as this is what we specialize in selling,'" does not properly make a claim that "RUS" is generic; rather, the difficulty Hair Are Us, Inc. displays in articulating the "meaning" of "RUS" demonstrates the fact that "RUS" is without generic or even descriptive meaning as applied to Geoffrey, LLC's services (or, for that matter, any goods or services whatsoever).<sup>3</sup>

As demonstrated, under no set of facts would Hair Are Us, Inc. be able to support its position that "RUS" is generic and that Reg. No. 3,859,458 for  is therefore subject to cancellation on that basis. Indeed, as a matter of law, neither "RUS" nor "TOYSRUS" can be deemed generic. Hair Are Us, Inc.'s genericness basis for cancellation of Geoffrey, LLC's mark is clearly meritless, and borders on frivolous.

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<sup>3</sup> Ironically, if Hair Are Us, Inc. were correct in asserting that "ARE US" is generic, it would not be entitled to registration of a mark merely combining the generic word "HAIR" with "ARE US."



**III. Hair Are Us, Inc.'s Counterclaim is Futile - U.S. Registration No. 3,859,458 Is but One of More Than 30 Registrations Pled in Geoffrey, LLC's Opposition.**

Hair Are Us, Inc. filed its counterclaim against only one of more than thirty registrations incorporating "ЯUS" or "R US" pled by Geoffrey, LLC in its notice of opposition against U.S. Application No. 86/222,809. As a result, this counterclaim for cancellation of U.S. Registration No. 3,859,458 is futile and cannot possibly result in Hair Are Us, Inc.'s requested relief of dismissal of Opposition No. 91221951 against its application. See, e.g., Dragon Bleu (SARL) v. VENM, LLC, 112 U.S.P.Q.2d 1925, 1929 n.10 (T.T.A.B. 2014) (dismissing claim with no leave to replead as would be futile); Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 U.S.P.Q. 151, 154 (T.T.A.B. 1983) (dismissing claim as futile where "leave to amend the pleading would serve no useful purpose").

**CONCLUSION**

In an amicable effort to address this claim, Geoffrey, LLC's counsel contacted counsel for Hair Are Us, Inc. in an attempt to open a dialog regarding the issue at hand and to request that the counterclaim be withdrawn for the reasons set forth above. Hair Are Us, Inc.'s counsel, however, did not make himself available with sufficient time for Geoffrey, LLC to comply with its filing deadline. Consequently, Geoffrey, LLC has

had to expend resources responding to this entirely baseless counterclaim.

\* \* \*

For all of the foregoing reasons, Geoffrey, LLC respectfully requests that the Board grant this motion to dismiss Hair Are Us, Inc.'s counterclaim with prejudice.

Respectfully submitted,

GEOFFREY, LLC

Date: October 2, 2015

By:



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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is addressed to the Trademark Trial and Appeal Board, Hon. Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451, and is being deposited via the Electronic System for Trademark Trials and Appeals (ESTTA) on October 2, 2015.

  
Megan E. Spitz

**CERTIFICATE OF SERVICE**

I, Megan E. Spitz, do hereby certify that I have on this  
2nd day of October 2015 served via electronic mail the foregoing  
MOTION TO DISMISS COUNTERCLAIM FOR FAILURE TO STATE A CLAIM to  
the following:

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